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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,725	02/27/2004	Hea Young Park Choo	DE-1557	9620

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EXAMINER

SPIVACK, PHYLLIS G

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 07/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/789,725	Applicant(s) PARK CHOO ET AL.	
	Examiner Phyllis G. Spivack	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

In response to the Restriction requirement and request for an election of species, set forth on March 21, 2006, Applicants have elected Group I, claims 1-7, and the species of Example 9, Table 2, without traverse. The Reply was filed April 26, 2006. A Preliminary Amendment filed February 27, 2004, in which claims 1-9 are presented and claim 8 is amended, is further acknowledged.

Accordingly, the subject matter initially under consideration are those methods of claims 1-7 wherein the benzoxazole depicted as Example 9 on page 13 is the elected species. Those methods for inhibiting 5-lipoxygenase comprising administering other compounds of instant formula I, and a method for preparing a compound of formula I, are withdrawn from consideration by the Examiner, 37 CFR 1.142(b), as drawn to non-elected inventions.

The undersigned Examiner supports the goal of the Office to advance prosecution as expediently as is reasonably possible. Co-operation is requested with respect to the timely submission of any references deemed pertinent to the present application along with Form PTO-1449.

Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

To satisfy the written description requirement, Applicant must convey with reasonable clarity, as of the filing date, that Applicant was in possession of the claimed invention. The issue of a lack of adequate written description also arises if the knowledge and level of skill in the art

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would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process. See Fujikawa v. Wattanasin, 93 F.3d 1559, 1571, 39 USPQ2d 1895, 1905 (Fed. Cir. 1996), (a "laundry list" disclosure of every possible moiety does not constitute a written description of every species in a genus because it would not "reasonably lead" those skilled in the art to any particular species); In re Ruschig, 379 F.2d 990, 995, 154 USPQ 118, 123 (CCPA 1967).

Possession may be shown in many ways. For example, describing an actual reduction to practice of the claimed invention may show possession. Possession may also be shown by a clear depiction of the invention in detailed drawings or in structural chemical formulas that permit a person skilled in the art to clearly recognize that Applicant had possession of the claimed invention. An adequate written description of the invention may be shown by any description of sufficient, relevant, identifying characteristics so long as a person skilled in the art would recognize that the inventor had possession of the claimed invention. For example, a specification may describe an actual reduction to practice by showing that the inventor constructed an embodiment or performed a process that met all the limitations of the claims and determined that the invention would work for its intended purpose. Applicants may show possession of an invention by disclosure of drawings or structural chemical formulas that are sufficiently detailed to show that Applicants were in possession of the claimed invention as a whole.

Applicants may also show that an invention is complete by disclosure of sufficiently detailed, relevant identifying characteristics that provide evidence Applicants were in possession of the claimed invention, i.e., complete or partial structure, other physical and/or chemical

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properties, functional characteristics when coupled with a known or disclosed correlation between function and structure, or some combination of such characteristics.

The written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice, reduction to drawings, or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the Applicant was in possession of the claimed genus. See Eli Lilly, 119 F.3d at 1568, 43 USPQ2d at 1406.

A "representative number of species" means that the species which are adequately described are representative of the entire genus. Thus, when there is substantial variation within the genus, one must describe a sufficient variety of species to reflect the variation within the genus. The disclosure of only one species encompassed within a genus adequately describes a claim directed to that genus only if the disclosure "indicates that the patentee has invented species sufficient to constitute the gen[us]."

Applicants have not conveyed possession of the invention with reasonable clarity to one skilled in the art. There are no working examples directed to administration of the benzoxazole compound of Example 9. While it is noted in Table 4, this compound exhibited "good" 5-lipoxygenase inhibition activity, an extrapolation to clinical efficacy for the treatment of such diverse pathologies as asthma, pertussis, psoriasis, arthritis, inflammatory bowel disease, cystic fibrosis, bronchitis, gout, sepsis, cardiac myoischemia, cardiac anaphylaxis, cerebrovascular convulsion, ischemia and allergic rhinitis is without adequate support. In view of the various

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functionalities encompassed in the options for the compounds of instant formula I, steric hindrance and receptor selectivity, and in particular, the diverse etiologies and involved organ systems of the recited disease states of instant claim 2, the skilled artisan would reasonably require a more detailed description of treatment. Applicants have not provided any working examples that would describe to one of ordinary skill in the art an embodiment that meets all the limitations thereof. Applicants have not described with sufficient clarity those compounds of formula I that are contemplated for treatment of any of the recited leukotriene-related diseases. Sufficient guidance to support predictable operability of the invention to one of ordinary skill in the art is absent.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Phyllis G. Spivack whose telephone number is 571-272-0585. The Examiner can normally be reached from 10:30 to 7 PM.

If attempts to reach the Examiner by telephone are unsuccessful after one business day, the Examiner's supervisor, Ardin Marschel, can be reached 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Phyllis Spivack

July 1, 2006

Phyllis Spivack

**PHYLLIS SPIVACK
PRIMARY EXAMINER**